



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,650	03/19/2004	Michael Borns	10070485-02	9645
27495 7590 08/10/2009 AGILENT TECHNOLOGIES INC P.O BOX 7599 BLDG E , LEGAL LOVELAND, CO 80537-0599			EXAMINER STAPLES, MARK	
			ART UNIT 1637	PAPER NUMBER
			NOTIFICATION DATE 08/10/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

Office Action Summary	Application No. 10/805,650	Applicant(s) BORNS, MICHAEL	
	Examiner MARK STAPLES	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 21-29, and 40-52 is/are pending in the application.
- 4a) Of the above claim(s) 12, 14, 16-18 and 21-24 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 13, 15, 25-29 and 40-52 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 12, 14, 16-18, 21-24 are withdrawn.

Claims 1-10, 13, 15, 25-29, and 40-52 are pending and at issue.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections that are Withdrawn

Claim Rejections Withdrawn - 35 USC § 103(a)

2. The rejection of claims 1-4, 7-11, 13, 15, 19, 25-30, and 40-46 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) is withdrawn. Applicant's arguments filed 04/06/2009 are persuasive.

3. The rejection of claims 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) and further in view of Sanger et al. (1977) is withdrawn. Applicant's arguments filed 04/06/2009 are persuasive.

4. The rejection of claims 47 and 48 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) is withdrawn. Applicant's arguments filed 04/06/2009 are persuasive.

5. The rejection of claims 49-52 under 35 U.S.C. 103(a) as being unpatentable over Wang (2001) and Dietrich et al. (2002) is withdrawn. Applicant's arguments filed 04/06/2009 are persuasive.

Allowable Subject Matter

6. Claims 1-10, 13, 15, 25-29, and 40-52 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter: no prior art was found which taught or fairly suggested methods of DNA synthesis comprising contacting a nucleic acid at a high pH of pH 9.3 to 12 or of pH 9.5 to 12 with a DNA polymerase fusion, wherein said DNA polymerase fusion comprises wild type *Pyrococcus furiosus* polymerase I fused to *Sulfolobus solfataricus* SSso7d protein. The closest prior art found was Wang (2001) who taught methods using a DNA polymerase fusion comprising wild type *Pyrococcus furiosus* polymerase I fused to *Sulfolobus solfataricus* SSso7d protein, but did not teach or fairly suggest using the DNA polymerase fusion at a high pH of pH 9.3 to 12 or of pH 9.5 to 12.

Non-Elected Claims

8. This application is in condition for allowance except for the presence of claims 12, 14, 16-18, and 21-24 directed to an invention non-elected with traverse in the reply filed on 01/19/2006. Failure to take action will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

It is noted that the withdrawn claims depend directly or indirectly from canceled claim 11 and/or have a lack of antecedent basis, and thus these previously withdrawn claims cannot presently be rejoined. Certain of the withdrawn claims have lack of antecedent basis for various recitations of amino acids at certain positions of a sequence, as there is no antecedent sequence recited. Applicant's representative was advised of these matters in a telephone call on 07/30/2009 and wished to consider these matters further.

Close

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Staples whose telephone number is (571) 272-9053. The examiner can normally be reached on Monday through Thursday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Application/Control Number: 10/805,650

Page 5

Art Unit: 1637

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Staples

/M. S./

Examiner, Art Unit 1637

July 31, 2009

/Kenneth R Horlick/

Primary Examiner, Art Unit 1637

/GARY BENZION/

Supervisory Patent Examiner, Art Unit 1637